



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,628	10/17/2003	Vivian Agura	60655.1800	2587
66170 7590 10/13/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER				
MYHRE, JAMES W				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
10/13/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM

DMIER@SWLAW.COM

JESLICK@SWLAW.COM

Office Action Summary

Application No.

10/688,628

Applicant(s)

AGURA ET AL.

Examiner

JAMES W. MYHRE

Art Unit

3688

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Amendment filed on September 3, 2010. The Amendment added new Claims 29-33 and amended Claims 17, 25, 27, and 28. Claims 1-16 were previously canceled. Thus, the currently pending claims considered below are Claims 17-33.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 17-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Amendment filed on September 3, 2010 introduced two new limitations in the independent claims (Claims 17, 27, and 28), namely: *"requesting, by the computer based system, at least one of profile information and a selection to create a new profile for the second account"* and *"accessing the computer based system in response to*

receiving the profile information, wherein the profile information is received to define the non-tangible item”.

A search of the original specification filed on October 17, 2003 failed to locate any discussion about “profile”, “profiles”, or “profile information”. Thus, there is no support within the specification for either of the two new limitations.

Dependent claims 18-26 and 29-33 inherently include the same limitations as their parents and are likewise rejected.

In order to prosecute the currently amended claims, the Examiner will consider the “profile information” as any information about the non-tangible item, such as an account number, mailing address, routing number, name, etc. as alluded to by the final clause of the second limitations: “*wherein the profile information is received to define the non-tangible item*” (emphasis added).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 17-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredregill et al (US 2005/0144074) in view of Davis (US 2004/0193491).

Claims 17, 27, and 28: Fredregill discloses a system, method and computer-readable storage medium for managing an on-line marketplace, comprising:

- a. receiving a selection of a non-tangible item (e.g. a service or "certificates for travel related awards")(page 2, paragraph 0016; page 5, paragraph 0031; page 10, paragraph 0056; and page 13, paragraph 0072);
- b. placing an indicator of the non-tangible item in an electronic shopping cart (page 10, paragraph 0056 and page 13, paragraph 0072);
- c. receiving a first request to purchase the non-tangible item (page 13, paragraph 0072 - page 14, paragraph 0073);
- d. calculating a first amount of at least one of a loyalty points and a monetary value of said loyalty points to purchase the non-tangible item (page 13, paragraph 0072 – page 14, paragraph 0073); and

e. debiting first loyalty points from a first loyalty account for applying to at least a portion of the first amount (page 13, paragraph 0072 – page 14, paragraph 0073).

Fredregill does not explicitly disclose receiving account information for a second selected account associated with the non-tangible item and transferring the non-tangible item to the second account. However, Davis discloses a similar system, method, and computer-readable medium for managing an on-line marketplace in which the consumer identifies a second account (e.g. charity, retirement savings account, or mutual fund)(Figure 13, item 1320 and page 3, paragraph 0032 and paragraph 0036 – page 4, paragraph 0040) into which the non-tangible item (cash value of the redeemed loyalty points) is transferred (page 4, paragraph 0040). Davis also discloses several known programs that allowed a consumer to redeem loyalty points or miles for merchandise or donations to charity (e.g. GoldPoints™, TruCash™, TLS™, MileDonor™, etc.), for cash rebates (e.g. TruCash™), and for gift certificates of any amount over \$25 to the recipient of their choice (e.g. SaveDaily™). Finally, Davis further discloses allowing the consumer to select to redeem their earned loyalty points by transferring the monetary equivalent to an investment account or to the account of another member (Figures 9 and 12). Additionally, Davis discloses requesting and receiving from the consumer a selection of a second account (e.g. a new investment account) or information about the second account (e.g. an existing investment entity and account number), i.e. newly added limitations of *"requesting, by the computer based system, at least one of profile information and a selection to create a new profile for the second account;"* and

"accessing the computer based system in response to receiving the profile information, wherein the profile information is received to define the non-tangible-item." Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Fredregill to allow the consumer to purchase non-tangible items such as investments into mutual funds/IRA accounts, charities, or cash rebates and to enter the profile information about the desired second account. One would have been motivated to allow the consumer to purchase such non-tangible items in order to assist consumers to set aside funds for savings and to increase charity donations as discussed by Davis (page 1, paragraph 0003).

Claims 18-20: Fredregill and Davis disclose the method as in Claim 17 above, and Davis explicitly discloses that the non-tangible item is a donation to charity, an investment in a retirement savings account (e.g. IRA account), or a cash rebate (i.e. monetary credit) (page 1, paragraph 0004 and page 3, paragraph 0032). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Fredregill to allow the consumer to purchase non-tangible items such as investments into mutual funds, retirement account (IRAs), charities, or to receive cash rebates. One would have been motivated to allow the consumer to purchase non-tangible items in order to assist customers to set aside funds for savings and to increase charity donations as discussed by Davis (page 1, paragraph 0003).

Claim 21: Fredregill and Davis disclose the method as in Claim 17 above, but do not explicitly disclose that the non-tangible item is frequent flyer miles. However, Fredregill discloses a "transfer points function" that "allows the retailer to assist customers in consolidating points between two customer accounts." (page 7, paragraph 0041). Additionally, Davis discloses that the consumer selects the desired option for redeeming the loyalty points, where "These options include, but are not limited to, cash, college savings fund, retirement savings fund, mutual fund, money market account, a bond, savings account, checking account, charity savings account and any other financial vehicle." (page 3, paragraph 0037). The Examiner notes that "any other financial vehicle would include other loyalty programs such as frequent flyer miles or frequent shopper points. Furthermore, converting one type of loyalty award (e.g. points) for another type of loyalty award (e.g. miles) was well known at the time of the invention as shown by Dokken et al (US 2003/0225619)(Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Fredregill to allow the consumer to exchange (redeem) the loyalty points for frequent flyer miles or any other loyalty award. One would have been motivated to allow the consumer to exchange one type of award for another type in order to expedite reaching the required number of frequent flyer points for a desired prize, e.g. if the consumer is 500 frequent flyer points short of a desired prize, transferring the equivalent value of loyalty points to the frequent flyer account would allow the consumer to attain the prize without having to wait until they complete another flight (which may be months away for an individual, non-business consumer).

Claim 22: Fredregill and Davis disclose a method as in Claim 17 above, and Fredregill further discloses determining that the first loyalty account had an insufficient balance of points for the desired redemption, associating a second account with the consumer, and debiting the second account to cover the insufficient balance (page 7, paragraph 0041 and page 10, paragraph 0058 – page 11, paragraph 0059). Fredregill discloses a “transfer points function” that “allows the retailer to assist customers in consolidating points between two customer accounts.” (page 7, paragraph 0041).

Claim 23: Fredregill and Davis disclose a method as in Claim 17 above, and Fredregill further discloses determining a conversion ratio that is a mathematical proportion used to calculate a monetary value associated with the first loyalty points (page 5, paragraph 0027-0029 and page 12, paragraph 0065).

Claim 24: Fredregill and Davis disclose a method as in Claim 23 above, and Fredregill further discloses displaying a points calculator that is configured to determine a number of first loyalty points needed to purchase the non-tangible item (page 10, paragraphs 0056 and 0058).

Claim 25: Fredregill and Davis disclose a method as in Claim 17 above, and Fredregill further discloses receiving a second request to purchase a tangible item (page 2, paragraph 0016; page 10, paragraph 0056; and page 13, paragraph 0072); calculating

a second amount of loyalty points necessary to purchase the tangible item (page 13, paragraph 0072 – page 14, paragraph 0073); debiting the first loyalty account for the second amount of loyalty points (page 13, paragraph 0072 – page 14, paragraph 0073); and receiving shipping information associated with the tangible item (page 4, paragraph 0024 and page 10, paragraph 0058 – page 11, paragraph 0059). Fredregill discloses the consumer selecting a plurality of desired items, placing the selected items in a shopping cart, and keeping a running total of the number of loyalty points needed to purchase each item, subcombinations of items in the shopping cart, or all of the items in the shopping cart. Based on the consumer's selection of item(s) (if any) desired to be purchased using loyalty points, the system automatically calculated and debits the loyalty account with the appropriate number of loyalty points.

Claim 26: Fredregill and Davis discloses a method as in Claim 17 above, and Davis further discloses associating the second account with the on-line marketplace (page 3, paragraph 0036). Davis discloses that the consumer is shown a list of account payout options from which to select the desired account to which the monetary value of the redeemed loyalty points will be deposited. These accounts from which the consumer can select are pre-approved by the issuer, i.e. they are associated with the on-line marketplace. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Fredregill to associate the second accounts (e.g. charities) with the on-line marketplace. One would have been motivated to associate the accounts with the marketplace (e.g. pre-approve) in order to assure they

are legitimate accounts, thereby protecting the consumer from unscrupulous "charities" or other investment accounts.

7. Claims 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredregill et al (US 2005/0144074) in view of Davis (US 2004/0193491) as applied to claim 25 above, and further in view of Official Notice.

Claims 29-33: Fredregill and Davis disclose a method as in Claim 25 above, but do not explicitly disclose determining whether the tangible item is an independent or dependent item, i.e. whether the purchase of the item (independent item) is a prerequisite before purchasing of another item (dependent item), nor offering the consumer the corresponding independent or dependent item(s) based on the type of item initially selected. However, Official Notice is taken that it was old and well known within the marketing industry at the time of the invention to link corresponding items and to offer the link item(s) to consumer who purchase the corresponding linked item. For example, it was common when a consumer is purchasing a printer (independent item) for the salesperson to offer the consumer corresponding toner cartridges (dependent items) for that make and model of printer. Likewise, it was common for a salesperson to offer/recommend a higher-end computer (independent item) to a consumer who is purchasing software (dependent item) that requires more computing power than the consumer's current computer. This is known in the marketing arts as "up-sells" and "cross-sells". Therefore, it would have been obvious to one having ordinary skill in the

art at the time the invention was made for Fredregill to make such up-sell and cross-sell offers to the consumer. One would have been motivated to make these offers in order to increase the total sum of the transaction, thus increasing profits for the merchant.

The Examiner further notes that the offering of additional tangible (or non-tangible) products to the total purchase order does not affect and does not appear to be tied to the redemption of the loyalty points for the initial non-tangible item to which the invention is directed.

Response to Arguments

8. Applicant's arguments filed September 3, 2010 have been fully considered but they are not persuasive.

a. The Applicant argues that Fredregill "is a closed system that does not allow for the association of third party accounts"...and "does not allow a user to purchase non-tangible items (e.g. frequent flyer miles, charitable donations, or credits or monetary value) AND transfer such non-tangible items to a second account" (page 6). The Examiner notes that Fredregill discloses redeeming loyalty points for "gift certificates", "certificates, and certificates for travel-related awards" in addition to catalog items (page 5, paragraphs 0030-0031) and that the purchase may contain "products or services" (page 6, paragraph 0033). The certificates may include physical certificates that the customer prints out and takes to a merchant or else electronic certificates (i.e. non-tangible items) usable by the customer at on-line merchants (i.e. a non-tangible item that is a credit of monetary value as in Claim 20). Thus, when the customer uses

the certificate at the on-line merchant, the certificate (non-tangible item)(credit of monetary value) is transferred to the merchant's account (second account).

b. The Applicant also argues that Davis also requires that the certificate obtained from one system be used by accessing a different system and cites examples of savings certificates and travel awards (page 6). The Examiner notes that while Davis may cite savings certificates and travel awards as exemplary items for which the loyalty points may be redeemed, many other examples are also given, such as "cash, college savings fund, retirement savings fund, mutual fund, money market account, a bond, savings account, checking account, charity savings account and any other financial vehicle" (page 3, paragraph 0037). In Davis, the customer accesses their loyalty points account, enters the amount of loyalty points they wish to redeem, receives a certificate number verifying that they have the required number of loyalty points, and selects what type of non-tangible item (e.g. charity organization or savings account) to which the loyalty points' monetary value will be transferred. The issuer then "transfers the funds to the appropriate institution or individual" (page 3, paragraph 0032). These steps are all performed while the customer is accessing the loyalty program website. Thus, contrary to the Applicant's argument, the customer does not have to take the certificate to another system to redeem. The certificate is merely being used as the instrument that validates that the requested redemption and allows the system to track redemptions through their unique certificate numbers.

Combining this issuance and use of electronic certificates with Fredregill's redemption of loyalty points for certificates, such as gift certificates, would result in the electronic transference of the monetary value of the gift certificate to the designated account, such as a retirement or charity account.

c. The Applicant also argues in reference to the newly added limitations that neither Fredregill not Davis disclose requesting and receiving profile information that defines the non-tangible item. As discussed in the 112 1st rejection above, the Applicant's specification does not provide support for requesting, receiving, or utilizing any profile information. However, Fredregill discusses at length on how the customer's profile can be used to recommend tangible and non-tangible items to the customer. Furthermore, since both references allow the customer to select the non-tangible item for which the loyalty points are being redeemed, it is inherent that the system receives information about that item, such as the corresponding account number, mailing address, routing number, name, etc. in order to enable the system to complete the transfer of funds to that account (i.e. second account).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM
October 4, 2010

/James W Myhre/
Primary Examiner, Art Unit 3688